

REMARKS

This is a full and timely response to the non-final Official Action mailed November 21, 2002 (Paper No. 4). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 10, 11, 16 and 25 have been amended. Additionally, claims 5-7 and 20-24 are cancelled. No new claims are added. Thus, claims 1-4, 8-19 and 25 are currently pending for the Examiner's consideration.

In the outstanding Office Action, The Examiner rejected claims 7, 10, 11 and 16-19 under 35 U.S.C. § 112, second paragraph. Claim 7 has been cancelled. The other claims have been carefully reviewed in light of the Examiner's comments and amended as necessary.

Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

With regard to the prior art, the Examiner rejected claims 1, 5, 6, 7, 10-14 and 20-24 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,284,339 to Floegel et al. ("Floegel"), and claims 1, 8 and 9 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,258,214 to Cooledge et al. ("Cooledge"). For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker; and

depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

As disclosed in Applicant's specification at paragraph 66, the claimed "charge donor," is different and separate from the sticker print medium itself, and can be a variety of materials capable of adding a charge to the sticker print medium. (Spec., para. 66). In contrast, neither Floegel or Cooledge teaches or suggests "depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium."

Floegel teaches that a charge is developed by heating the print medium in the presence of an electric field to induce an electric dipole moment. (Col. 1, lines 57-63; and col. 3, lines 12-15). No charge donor is used. Moreover, this creation of a dipole moment is performed prior to printing which is also contrary to the claimed step of depositing a charge "after" printing. Cooledge teaches that an electrical charge is developed by friction when the print medium is moved over or against itself. (Col. 4, lines 1-4). Consequently, both Floegel and Cooledge fail to teach or suggest the claimed method of making an electrostatic sticker using a charge donor that is "separate from, and not a part of, said sticker print medium."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, neither Floegel nor Cooledge can anticipate claim 1. Thus, the rejections of claim 1 and its dependent claims, based on Floegel or Cooledge should be reconsidered and withdrawn.

The Examiner also rejects claims 12-15 as anticipated under 35 U.S.C. § 102(b) by Longtin ("Longtin"). For at least the following reasons, this rejection is respectfully traversed.

Claim 12 recites:

An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium;

an electrostatic charge deposited on a side of said sticker print medium; and

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

In contrast, Longtin teaches a roll (10) of printed stickers (30). Each sticker (30) is backed by a release liner (40), and the liners (40) are stuck on a carrier substrate (20).

Longtin does not teach or suggest a “blank” sheet of electrostatic print medium. The Office Action argues that each of the stickers (30) was “inherently blank before it was printed upon.” (Paper No. 2, p. 3). This may be true, but is irrelevant to the claimed invention.

Claim 12 recites both (1) a blank sheet of electrostatic print medium and (2) a backing on the blank sheet of print medium. There is no teaching or suggestion in Longtin that the release liner (40) is applied to the print medium or stickers (30) *before* the stickers are printed.

In response to this point, the recent Office Action states that “Longtin provides no evidence that the sheet is printed on before applying the backing. Applicant’s statement that Longtin does not disclose this feature is a mere allegation that is not supported by evidence.” (Paper No. 4, p. 10). This is clearly and demonstrably incorrect.

It is a matter of fact, not an unsupported allegation, that Longtin does not disclose a blank sheet of print medium with a backing. There is no portion of Longtin that can be cited that actually teaches or suggests a blank sheet of print medium with a backing. The recent Office Action provides no indication of where or how Longtin teaches the claimed blank sheet of print medium with a backing applied.

It is important to note that it is not the burden of the Applicant, in the first instance, to demonstrate that the prior art cannot teach the claimed invention. Rather, it is incumbent upon the Examiner to identify where in the reference each feature of the claimed invention may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). In the present case, Longtin has *not* been shown to teach or suggest the invention of claim 12. Rather, the Office Action seems to argue that Longtin merely does not preclude the possibility of the invention of claim 12. Much more is required to make out a *prima facie* case of unpatentability.

In reality, Longtin fails to teach or suggest the claimed print medium that is blank but also has a protective backing over an electrostatic charge. As noted before, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal

Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Longtin cannot anticipate the invention of claim 12 or render claim 12 unpatentable. Thus, the rejection of claim 12 and its dependent claims, based solely on Longtin, should be reconsidered and withdrawn.

Claim 25 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,992,121 to Rubino (“Rubino”). This rejection is respectfully traversed for at least the following reasons.

Claim 25 recites:

A business method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker print medium and a charge donor, other than said sticker print medium, for depositing an electrostatic charge on either side of said sticker print medium, wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are associated together to form said kit.

Merriam Webster's Collegiate® Dictionary, 10th Edition defines a “kit” as “a packaged collection of related material.” (<http://www.m-w.com>). Similarly, the American Heritage Dictionary of the English Language: Fourth Edition (2000) defines a “kit” as “1a. A set of articles or implements used for a specific purpose: a survival kit; a shaving kit. b. A container for such a set. . . . 3. A packaged set of related materials: a sales kit.” (<http://www.bartleby.com/61/85/K0078500.html>).

In citing Rubino, the recent Office Action refers expressly to the Abstract, which reads as follows in its entirety:

A method of adhering a relatively heavy sheet or three-dimensional object to a support surface using an electrostatically chargeable intermediate sheet, including providing a sheet which is capable of carrying a charge sufficient to support at least three ounces per square foot of intermediate sheet surface for at least one month and charging the sheet using a contaminant free buffer material selected from the group consisting of wool, natural fiber, artificial fiber and chamois. A decorative hanging including such an intermediate sheet is also disclosed.

As cited, Rubino fails to teach or suggest a “kit” comprising an electrostatic sticker print medium and a charge donor. Rubino does not teach or suggest the packaging or association of the recited elements as would constitute a “kit.” Moreover, Rubino does not teach or suggest that such a kit is provided commercially under a “business method.”

Thus, Rubino fails to teach or suggest the kit and the business method recited by claim 25. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citations omitted). Therefore, the rejection of claim 25 based on Rubino is deficient and should be reconsidered and withdrawn.

Claims 16-19 were under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 2,293,887 to Chamberlain (“Chamberlain”). For at least the following reasons, this rejection is respectfully traversed.

Similar to claim 25, claim 16 recites:

An electrostatic sticker kit comprising
a kit including:
at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an
electrostatic charge on either side of said sticker print medium;
wherein said at least one blank sheet of sticker print medium and said charge
donor are associated together in said kit.

In contrast, Chamberlain fails to teach or suggest the claimed kit in which an electrostatic sticker print medium and a charge donor are associated. The outstanding Office Action seems to acknowledge that Chamberlain does not teach the claimed kit. However, the Office Action instead argues that “the sticker and charge donor *could be* considered part of a kit . . .” (Paper No. 4, p. 7) (emphasis added). This is insufficient as a matter of law.

The rejection of a claim based on prior art may not be established by probabilities or possibilities. MPEP § 2112. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)

(citations omitted). "[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly [anticipated] characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis added). *See also*, MPEP § 2112 (quoting Levy).

Consequently, Chamberlain does not teach or suggest the claimed "kit" with its recited constituents. Moreover, it is impermissible to read such a teaching into Chamberlain when no such teaching or suggestion there exists. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citations omitted). Therefore, the rejection of claims 16-19 based on Chamberlain is deficient and should be reconsidered and withdrawn.

Some of the dependent claims were rejected in the recent Office Action under 35 U.S.C. § 103(a) using various combinations of the prior art references of record. For at least the reasons given above with regard to the various independent claims, each of the pending dependent claims is patentable over the prior art of record. Additionally, Applicant notes that there are additional reasons supporting the patentability of the pending dependent claims over the prior art of record in some instances.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Legal Dept.
Hewlett-Packard Company
1000 NE Circle Blvd
Corvallis OR 97330
tele: (541) 715-0159
fax: (541) 715-8581

Respectfully submitted,


W. Bradley Haymond
Registration No. 35,186

Dated: 2/14/03

Claims Appendix

For the convenience of the Examiner, and in accordance with 37 CFR 1.121(c)(1)(ii), all pending claims are presented below in their current form. Amendments made by the present paper are indicated with added material being underlined and deleted material being bracketed.

1. (once amended) A method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker; and

depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

2. The method of claim 1, further comprising reversing said user-selected image before said printing said user-selected image on said sticker print medium.

3. The method of claim 2, further comprising reversing said user-selected image with a print driver of a host computer.

4. The method of claim 2, further comprising reversing said user-selected image with firmware of a printer which performs said printing of said user-selected image.

5-7. (canceled)

8. The method of claim 1, further comprising depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image.

9. The method of claim 1, further comprising perforating one or more sections of said sticker print medium.

10. (once amended) A method of using an electrostatic sticker produced by the [The] method of claim [5] 1, [further] comprising applying said electrostatic sticker such [tat] that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied.

11. (once amended) A method of using an electrostatic sticker produced by the [The] method of claim 8, [further] comprising applying said electrostatic sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied.

12. (once amended) An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium;
an electrostatic charge deposited on a side of said sticker print medium; and
a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

13. The sticker print medium of claim 12, wherein said sticker print medium is made of vinyl.

14. The sticker print medium of claim 12, wherein said sheet of electrostatic print medium is transparent.

15. The sticker print medium of claim 12, wherein said sheet of electrostatic print medium is perforated to define a plurality of sticker panes.

16. (once amended) An electrostatic sticker kit comprising[:]
a kit including:

at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an electrostatic
charge on either side of said sticker print medium [after said sticker print medium has been
printed with and image];

wherein said at least one blank sheet of [stick] sticker print medium and said charge
donor are associated together in said kit.

17. The sticker print medium of claim 16, wherein said sticker print medium is
made of vinyl.

18. The sticker print medium of claim 16, wherein said sheet of electrostatic print
medium is transparent.

19. The sticker print medium of claim 16, wherein said sheet of electrostatic print
medium is perforated to define a plurality of sticker panes.

20-24. (cancelled)

25. (once amended) A business method comprising providing an
electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit
containing at least one blank sheet of an electrostatic sticker print medium and a charge
donor, other than said sticker print medium, for depositing an electrostatic charge on either
side of said sticker print medium, wherein said at least one blank sheet of an electrostatic
sticker print medium and said charge donor are associated together to form said kit.